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**MAILED**

**SEP 22 2009**

**OFFICE OF PETITIONS**

In re Application of  
Becker, et al.  
Application No.: 10/553,607  
Filed: November 3, 2006  
Attorney Docket No.09432.0062-00

:  
: LETTER REGARDING  
: PATENT TERM ADJUSTMENT  
:  
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This is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR REVIEW OF CALCULATION" filed July 24, 2009. Pursuant to applicants' duty of good faith and candor to the Office, applicants requests that the determination of patent term adjustment under 35 U.S.C 154(b) be reviewed for accuracy.

The request for review of determination of the patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

On June 11, 2009, a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) was mailed indicating that the patent term adjustment to date is 36 days. On July 24, 2009, applicants submitted the instant comment. Applicants disclose that based on their calculations the patent term adjustment should be 13 days. Specifically, applicants state that:

Applicants believe that there should have been a 40 day deduction of patent term adjustment from the date the Applicants filed a Supplemental Information Disclosure Statement on July 9, 2008 rather than a 17 day delay for filing the previously filed Supplemental Information Disclosure Statement on June 16, 2008.

*Excerpt from Notice of Possible PTO Error in the Determination of Patent Term Adjustment and Request for Review of Calculation, filed July 24, 2009, pgs. 1-2.*

A review of the record reveals that an additional period of reduction is warranted under 37 CFR 1.704(c)(8) for the filing of an Information Disclosure Statement on July 9, 2008.

37 CFR 1.704(c)(8) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date the supplemental reply or other such paper was filed.

37 CFR 1.704(d) provides that:

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

It is undisputed that applicants filed Information Disclosure Statements on June 16, 2008, and July 9, 2008, after a response was filed to the non-final Office action on May 30, 2008. A review of the Information Disclosure Statements, filed June 16, 2008, and July 9, 2008, reveals that the Information Disclosure Statements were not accompanied by statements under 37 CFR 1.704(d). Furthermore, the record does not support a conclusion that the examiner expressly requested the filing of either

Information Disclosure Statement. Thus, applicants failed to engage in reasonable efforts to conclude prosecution of the application.

Pursuant to 37 CFR 1.704(c)(8), a first period of reduction of 17 days was entered, counting the number of days beginning on the day after the date the initial reply was filed, May 31, 2008, and ending on the date that the IDS was filed, June 16, 2008. Pursuant to 37 CFR 1.704(c)(8), a second period of reduction 40 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, May 31, 2008, and ending on the date that the second IDS was filed, July 9, 2008.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." In this instance, the first period of reduction of 17 days (from May 31, 2008 to June 16, 2008) totally overlaps with the second period of reduction of 40 days (from May 31, 2008 to July 9, 2008). Accordingly, an additional period of reduction of 23 days (i.e. the non-overlapping period from June 17, 2008 to July 9, 2008) is warranted and will be entered.

Additionally, a review of the application history reveals that a period of reduction is warranted under 37 CFR 1.704(b)<sup>1</sup> for the

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<sup>1</sup> 37 CFR 1.704(b) states:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

filing of a reply in the form of a Declaration and Power of Attorney on November 3, 2006, in excess of the three month period from the June 27, 2006, mailing date of the Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US). Thus, applicants failed to engage in reasonable efforts to conclude processing or examination of this application. Accordingly, the period of adjustment set forth in § 1.703 should have been reduced under 37 CFR 1.704(b) by 37 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), September 28, 2006, and ending on the date the reply was filed, November 3, 2006. A period of reduction of 37 days will be entered.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance is **zero (0) days** (57 days of Office delay - 81 (37 + 1 + 17 + 23 + 3) days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in the calculation of the Patent Term Adjustment, the Office will not assess the \$200.00 application fee under 37 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Telephone inquiries regarding this specific matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Monday  
Date: 9/21/2009

# **PALM INTRANET**

Time: 11:53:05

PTA Calculations for Application: <u>10/553607</u>			
Application Filing Date:	11/03/2006	PTO Delay (PTO):	57
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	21
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-60		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
67	09/21/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		37	
66	09/21/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		23	
58	06/11/2009	MAIL NOTICE OF ALLOWANCE			
57	06/10/2009	ISSUE REVISION COMPLETED			
56	06/10/2009	DOCUMENT VERIFICATION			
55	06/10/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
54	06/10/2009	EXAMINER'S AMENDMENT COMMUNICATION			
53	06/09/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
52	06/08/2009	NOTICE OF ALLOWABILITY			
51	04/13/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
50	04/10/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
49	04/13/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
48	04/13/2009	REFERENCE CAPTURE ON IDS			
47	04/13/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		3	44
46	04/10/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
45	04/17/2009	DATE FORWARDED TO EXAMINER			
44	04/10/2009	RESPONSE AFTER NON-FINAL ACTION			
43	04/13/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
42	04/13/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

41	04/10/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
40	01/22/2009	MAIL NON-FINAL REJECTION			
39	01/21/2009	NON-FINAL REJECTION			
38	12/16/2008	DATE FORWARDED TO EXAMINER			
37	12/12/2008	AMENDMENT AFTER FINAL REJECTION			
36	09/15/2008	MAIL FINAL REJECTION (PTOL - 326)			
35	09/02/2008	FINAL REJECTION			
34	06/16/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
33	07/09/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
32	07/09/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
31	06/16/2008	REFERENCE CAPTURE ON IDS			
30	06/16/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		17	28
29	06/29/2008	DATE FORWARDED TO EXAMINER			
28	05/30/2008	RESPONSE AFTER NON-FINAL ACTION		1	25
27	05/30/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
26	06/16/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	02/29/2008	MAIL NON-FINAL REJECTION	57		14
24	02/19/2008	NON-FINAL REJECTION			
22	01/23/2008	CASE DOCKETED TO EXAMINER IN GAU			
21	10/17/2007	WITHDRAW FLAGGED FOR 5/25			
20	10/15/2007	FLAGGED FOR 5/25			
17	04/12/2007	PG-PUB ISSUE NOTIFICATION			
16	03/01/2007	CASE DOCKETED TO EXAMINER IN GAU			
15	02/07/2007	TRANSFER INQUIRY TO GAU			
14	11/03/2006	371 COMPLETION DATE			
13	01/03/2007	APPLICATION DISPATCHED FROM OIPE			
12	01/03/2007	NOTICE OF DO/EO ACCEPTANCE MAILED			
11	11/03/2006	ADDITIONAL APPLICATION FILING FEES			
10	11/03/2006	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
5	01/03/2007	CORRESPONDENCE ADDRESS CHANGE			
4	12/13/2006	CASE CLASSIFIED BY OIPE			

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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